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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,336	11/23/1999	JOHANNES WILLEM HOFSTRAAT	AEM2527PIUS	2490

21302 7590 02/04/2002

KNOBLE & YOSHIDA
EIGHT PENN CENTER
SUITE 1350, 1628 JOHN F KENNEDY BLVD
PHILADELPHIA, PA 19103

EXAMINER

GABEL, GAIENE

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 02/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/380,336

Applicant(s)

HOFSTRAAT, JOHANNES WILLEM

Examiner

Gailene R. Gabel

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 December 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-14.

Claim(s) withdrawn from consideration: NONE.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Christopher L. Chin
CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641

Gailene R. Gabel
1/31/02

Continuation of 2. NOTE: The amendment to the claims failed to overcome current indefiniteness issues set forth in Paper No. 12. Specifically, claim 1 recites "mixing an analyte, a specific binding partner, and the labeled immunoreactant to form a mixture" but fails to set forth what interaction, i.e. binding to form a ternary complex, takes place so as to effect luminence in the mixture and how luminence relates to the detection of the analyte, i.e. luminence detected is indicative of the presence of analyte in the sample. Further, the recitation of "a single photon of light" is a new limitation that requires further consideration and search in evaluating novelty of the claimed invention. Lastly, the recitation of "a single photon of light" does not appear to have literal support in the specification; thus, raising the issue of new matter.

Continuation of 5. does NOT place the application in condition for allowance because: the arguments and declaration set forth by Applicant are not persuasive. Specifically, Applicant argues that the claimed invention requires that the sensitizing moiety is in contact or directly connected to the lanthanide ion; however, such limitation is not distinctly recited in the claims, i.e. claim 10 recites that the sensitizing moiety is in contact with the ligand (which is complexed with the lanthanide ion). Further, Applicant's declaration appears to address a problem with certain lanthanide ions, namely terbium and europium, in the teaching of Wieder in defining the difference between the Wieder reference and the claimed invention; however, Applicant fails to acknowledge Wieder's equivalent teaching of neodymium and erbium at column 5 of the reference and which the Office relies upon for the pending rejection.